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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,287	02/12/2007	Thomas Bocher	GK-OEH-237/500814.20139	2755

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REED SMITH, LLP
ATTN: PATENT RECORDS DEPARTMENT
599 LEXINGTON AVENUE, 29TH FLOOR
NEW YORK, NY 10022-7650

EXAMINER

PRITCHETT, JOSHUA L

ART UNIT	PAPER NUMBER
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2872

MAIL DATE	DELIVERY MODE
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10/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/578,287	Applicant(s) BOCHER ET AL.	
	Examiner JOSHUA L. PRITCHETT	Art Unit 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8 and 10-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This action is in response to Amendment filed July 18, 2008. Claims 8, 10 and 13 were amended and claim 9 was cancelled as requested by the applicant.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abe (US 2004/0001253).

Regarding claims 8 and 11, Abe teaches a stand (11) a first imaging system comprising an objective and tube (7) a first illumination system (1-6) for vertical illumination comprising a lamp, collector and a condenser (abstract) and an object stage (8) which is located below the objective for the upright variant and above the objective for the inverted variant (Figs. 3 and 12) the enclosed condenser being an illumination module (abstract) the first imaging system for implementing the upright variant being determined by the objective module, the tube and a first optical path lying between the tube and the objective module that is mounted above the object

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stage (Fig. 12) a second imaging system being provided for the inverted variant, which second imaging system being determined by the objective module the tube and a second optical path lying between the tube and the objective module that is mounted below the object stage (Fig. 3) and optical element present in the first optical path or second optical path being calculated in such a way that an imaging of an object by the first imaging system is identical to an imaging of the object by the second imaging system (Figs. 3 and 12). Abe teaches the objective module has an imaging interface (between 7 and 8) on the objective module side and an illumination interface (between 9 and 6) on the objective module side; the illumination module having an illumination interface on the illumination side (between 9 and 6) the objective module communicating with the stand by its objective interface on the objective module side alternately by a top imaging interface or a bottom imaging interface to use the microscope alternately as an upright microscope or as an inverted microscope (Figs. 3 and 12) the illumination module being connected to the stand by its illumination interface on the illumination side alternately by a top illumination interface or a bottom illumination interface so that in connection with the lamp it alternately makes available illumination for the upright variant of the microscope or the inverted variant of the microscope (Figs. 3 and 12) the stand being hollow (Figs. 3 and 12) and the portions of the first imaging system and second imaging system lying between the tube and the top imaging interface or bottom interface extending within the interior of the stand (Figs. 3 and 12). Abe lacks reference to the beam-splitting enclosed with the objective. Abe suggests the beam-splitter (9) being enclosed with the objective because the beam-splitting element moves during conversion from the upright to the inverted variant. The beam-splitter also maintains the same spatial relationship with the objective (Figs. 3 and 12). Abe lacks reference to the fastening

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of the objective module. Michel teaches the objective module being fastened to the stand by its illumination interface on the objective module side by the respective free top illumination interface or bottom illumination surface (Fig. 1) a bottom lamp interface(5a) and a top lamp interface (5b) provided opposite from the illumination interfaces the lamp being attached alternately to this bottom lamp interface or top lamp interface in order to outfit both microscope alternately with vertical illumination or transmitted illumination (Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Abe invention include the fastener location and lamp location as taught by Michel for the purpose of limiting the number of parts moved to convert from upright to inverted variant and thus allow more rapid conversion and alleviate alignment problems. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Abe invention enclose the beam-splitter with the objective as suggested by Abe for the purpose of alleviating alignment problems that may be associated with moving the elements separately.

Regarding claim 10, Abe teaches the stand has a shape of 'C' the first side of the 'C' forming the stand base and the tube being mounted at the second side of the 'C', wherein both sides have, at their free end, rectangular recess which face one another the oppositely located surfaces in the recesses form the top and bottom imaging interfaces and the surfaces perpendicular thereto form the top and bottom illumination interfaces (Figs. 3 and 12).

Regarding claim 12, Abe teaches the objective module is fixedly connected to the stand and the stand is rotated by 180-degrees with its base surface arranged upward in order to invert the upright variant into the inverted variant wherein the objective module has on the objective module side an imaging interface that alternately connects indirectly via a camera tube or an

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intermediate tube (6) to a tube-side tube interface located at the tube so that the first optical path is determined by the optical elements of the camera tube which participate in the visually accessible imaging and the second optical path is determined by the optical elements of the intermediate tube (Figs. 3 and 12).

Regarding claims 13 and 14, Abe teaches the use of parallel light path (Fig. 9).

Response to Arguments

Applicant's arguments filed July 18, 2008 have been fully considered but they are not persuasive.

Applicant argues Abe fails to teach the imaging system switchable between an upright and inverted variant. Michel teaches this limitation as stated in the rejection above.

Applicant argues Michel fails to teach illumination switchable between vertical and transmitted illumination. Abe teaches this limitation as stated in the rejection above. Further, Michel shows in transmitted illumination in Fig. 1 with light from source 5a going to the sample and vertical illumination in Fig. 3 with light from 15b going to the sample.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA L. PRITCHETT whose telephone number is (571)272-2318. The examiner can normally be reached on Monday - Friday 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on 571-272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joshua L Pritchett/
Primary Examiner
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